



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

U.S. SERIAL NO. : 10/729,167
APPLICANTS : Fournay, et al.
FILING DATE : 4 December 2003
PATENT NO. : 7,618,940
ISSUED : 17 November 2009
GROUP ART UNIT : 1654
EXAMINER : Roy R. Teller
DOCKET NO. : FP0602.2 US
TITLE : FAT REGULATION

Mail Stop Petition
Commissioner for Patents
PO Box 1450
Alexandria VA 22313-1450

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
INDICATED ON FACE OF PATENT (37 C.F.R. § 1.705)

Sir:

Applicants respectfully request reconsideration of the patent term adjustment ("PTA") indicated on the face of U.S. Patent No. 7,618,940. Pursuant to 37 C.F.R. § 1.705(d), this request is being timely filed within two (2) months of the 17 November 2009 issue date.

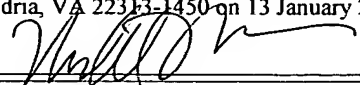
Applicants claim small entity status under 37 C.F.R. 1.27.

The Commissioner is hereby authorized to charge the total of the fee set forth in § 1.18(e) to Deposit Account No. 50-0811, referencing Docket No. FP0602.2 US.

Certificate of mailing or transmission under 37 CFR § 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on 13 January 2010.

Name: Michael Moores

Signature: 

I. Statement of Facts

1. Pursuant to 37 C.F.R. § 1.705(b)(2), Applicants respectfully submit the following statement of facts:

37 C.F.R. § 1.705(b)(2)(i) and (ii)

The PTA shown in the Notice of Allowance for U.S. Application No. 10/729,167 (mailed 17 July 2009) is 176 days. The PTA shown on the face of U.S. Patent No. 7,618,940 is 570 days. As discussed below, Applicants submit that the patent is entitled to an additional 495 days of PTA under 37 C.F.R. § 1.702.

Accordingly, the correct patent term adjustment under § 1.702 is 1065 days.

The basis upon which Applicants seek adjustment is as follows:

(a) Period of Adjustment Pursuant to 37 C.F.R. §§ 1.702(a) and 1.703(a)

Pursuant to 37 C.F.R. § 1.702(a)(1), the USPTO failed to mail at least one of a notification under 35 U.S.C. § 132 or a notice of allowance under 35 U.S.C. § 151 not later than fourteen months after the date on which the application was filed under 35 U.S.C. § 111(a):

The date of filing for this application is December 4, 2003. The USPTO did not issue a Restriction Requirement until June 14, 2006, resulting in 495 days of USPTO delay.

Pursuant to 37 C.F.R. § 1.702(a)(2), the USPTO failed to mail at least one of an action under 35 U.S.C. § 132 or a notice of allowance under 35 U.S.C. § 151 not later than four months after the date on which a reply under 37 C.F.R. § 1.111 was filed:

Applicants filed a reply under 37 C.F.R. § 1.111 on March 8, 2007 and the USPTO did not mail an Office Action until August 22, 2007, resulting in an additional 45 days of USPTO delay.

Thus, there is a total of 540 days of USPTO delay ("A delay") under this section.

(b) Period of Adjustment Pursuant to 37 C.F.R. §§ 1.702(b) and 1.703(b)

Pursuant to 37 C.F.R. § 1.702(b), if the USPTO fails to issue a patent within three years of the actual filing date of the application, Applicants will be entitled to additional PTA beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. § 111(a) and ending on the issue date, subject to exclusion of any time consumed by continued examination of the application under 35 U.S.C. § 132(b).

The date of filing this application under 35 U.S.C. § 111(a) is December 4, 2003, and the date that is three years after this date is December 4, 2006. U.S. Patent No. 7,618,940 issued on November 17, 2009. A request for continued examination under 35 U.S.C. § 132(b) was filed June 25, 2009, which is 934 days beyond the December 4, 2006 date, resulting in 934 days of USPTO delay.

Since time consumed by continued examination is excluded from PTA, Applicants are entitled to 934 days of USPTO delay ("B delay") under this section.

(c) Period of Adjustment Pursuant to 37 C.F.R. §§ 1.704(a) and 1.704(b)

Pursuant to 37 C.F.R. § 1.702(b), Applicants are deemed to have failed to engage in reasonable efforts to conclude examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to an action by the Office making any rejection, objection, argument, or other request:

The USPTO mailed a Restriction Requirement on June 14, 2006 and Applicants did not file a response until March 8, 2007, resulting in 175 days of Applicants delay.

The USPTO mailed an Office Action on August 22, 2007 and Applicants did not file a response until February 26, 2008, resulting in 96 days of Applicants delay.

The USPTO mailed a Final Office Action on May 23, 2008 and Applicants did not file a response until November 24, 2008, resulting in 93 days of Applicants delay.

Thus, there is a total of 364 days of Applicants delay under this section.

(d) Additional Period of Adjustment Pursuant to C.F.R. §§ 1.702 and 1.703

The 176 days of PTA shown in the Notice of Allowance for U.S. Application No. 10/729,167 (mailed 17 July 2009) indicated that Applicants would receive 540 days of "A delay" in the final PTA determination (i.e., 540 A delay – 364 Applicants delay = 176 days). However, the net balance of 570 days of PTA shown on the face of U.S. Patent No. 7,618,940 indicates that none of the "A delay" (i.e., period of adjustment pursuant to 37 C.F.R. §§ 1.702(a) and 1.703(a)) was included in the final PTA.

Pursuant to 37 C.F.R. § 1.703(c), the period of adjustment under § 1.702(c) is the sum of the periods under § 1.703(a) and 1.703(b), to the extent that the periods are not overlapping.

In *Wyeth v. Kappos*, the Federal Circuit recently interpreted the meaning of 37 C.F.R. § 1.703(c) for purposes of determining patent term adjustment. *Wyeth v. Kappos*, No. 2009-1120 (Fed. Cir. Jan. 7, 2010). The Federal Circuit held that the overlap limitation in § 1.703 “only arises when ‘periods of delay’ resulting from violations of the three guarantees ‘overlap.’” In particular, the Court stated that “before the three-year mark, no ‘overlap’ can transpire between the A delay [C.F.R. § 1.703(a)] and the B delay [C.F.R. § 1.703(b)] because the B delay has yet to begin or take any effect. If an A delay occurs on one day and a B delay occurs on a different day, those two days do not “overlap” under [C.F.R. § 1.703(c)].”

As discussed *supra* in Section I(a), a total of 540 days of “A delay” occurred during the prosecution of U.S. Patent No. 7,618,940. However, 495 of the “A delay” days occurred before the three-year pendency mark and thus did not overlap with the 934 days of “B delay.” Therefore, Applicants are entitled to at least 495 days of “A delay” under 37 C.F.R. §§ 1.702 and 1.703.

In sum, the patent term adjustment for U.S. Patent No. 7,618,940 should be 1065 days—i.e., 540 (A delay) + 934 (B delay) - 45 (“overlap”) - 364 (Applicants delay). The PTA currently shown on the face of U.S. Patent No. 7,618,940 is 570 days. Accordingly, Applicants are entitled to an additional 495 days of PTA under 37 C.F.R. § 1.702 (b) for a total of 1065 days.

2. 37 C.F.R. § 1.705(b)(2)(iii)

U.S. Patent No. 7,618,940 is not subject to a Terminal Disclaimer.

3. 37 CFR § 1.705(b)(2)(iv)

Other than the circumstances set forth above in Section I(c), Applicants are not aware of any other circumstances during the prosecution of the above-identified patent application that constitute a failure to engage in reasonable efforts to conclude processing or examination of this application as set forth in 37 C.F.R. § 1.704.

CONCLUSION

Applicants respectfully request that U.S. Patent No. 7,618,940 be granted an additional 495 days of PTA under 37 C.F.R. § 1.702 (b), for a total of 1065 days of PTA.


Applicants claim small entity status under 37 C.F.R. 1.27.

The Commissioner is hereby authorized to charge the total of the fee set forth in § 1.18(e) to Deposit Account No. 50-0811, referencing Docket No. FP0602.2 US.

Please call Applicant's representative at 415-978-1742 with any questions regarding the present communication or the above-identified application.

Respectfully submitted,

Date: 13 January 2010

By: 
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